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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/811,648	03/05/1997	DAN KIKINIS	P1523CIP	1380

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EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 05/23/2002

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Pat

**Office Action Summary**

Application No.

08/811,648

Applicant(s)

KIKINIS, DAN

Examiner

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-9 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-9 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. This action is in response to the Reply and Appellant's Brief received 08 March 2002.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
3. The application has been examined. **Claims 1-4, 7-9 and 13-16** are pending. The objections and rejections cited are as stated below:

#### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1-4, 7-9 and 13-16** are rejected under 35 U.S.C. 102(e) as being anticipated by Goodman, U.S. Patent No. 5,844,596.
6. Regarding **claim 1**, Goodman discloses *a networking system for a home or business site* [see Goodman, Abstract, Col. 3, lines 1-56], *comprising: a bridge adapter* [see Goodman, item 400] *unit having an inlet port for receiving public network protocol signals* [see Goodman, Col.

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8, lines 9-10]; *and a telephone wiring structure in the site, the wiring structure having multiple end points and one or more junctions* [see Goodman, Col. 8, lines 1-25], *and connected at a single point to an outlet port of the bridge adapter unit; characterized in that the bridge adapter unit drives the telephone wiring structure according to a Local Area Network (LAN) protocol, translates the public network protocol signals to the LAN protocol, and modulates the signals in a manner to correct signal variations at the end points due to having multiple end points driven from a single point at the bridge adapter unit, (see Applicant's specification on page 9, that is being used as a guide in interpreting this particular limitation),* [see Goodman, Col. 9, lines 12-25, Col. 24, lines 8-16, Col. 31, lines 26-30, Col. 60, lines 15-29, Col. 67, lines 30-57]. By this rationale **claim 1** is rejected.

7. Regarding **claim 2**, Goodman further discloses *one or more converters* [see Goodman, item 452] *connected at individual ones of the end points, the one or more converters comprising each an outlet port to connect to a single-media or a multimedia device, the converters converting the LAN signals to a form required by the single-media or multi-media device* (Goodman teaches converters that convert signals from voice-band and transmits them through filters to local network where they communicate with the telephone device), [see Goodman, Col. 4, lines 60-67, Col. 5, lines 1-15, Col. 11, lines 65-67, Col. 12, lines 1-8 and Col. 54, lines 56-67]. By this rationale **claim 2** is rejected.

8. Regarding **claim 3**, Goodman further discloses *one or more single-media or multi-media devices connected to one or more of the converters* [see rejection of claim 2, supra]. By this rationale **claim 3** is rejected.

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Regarding **claim 13**, Goodman further *discloses individual ones of the converters are integrated into individual ones of the single-media or multi-media devices* [see Goodman, Col. 15, lines 16-60]. By this rationale **claim 13** is rejected.

9. Regarding **claim 14**, Goodman further discloses *wherein individual ones of the converters are internal modules of individual ones of the single-media or multimedia devices* [see Goodman, Col. 15, lines 16-60]. By this rationale **claim 14** is rejected.

10. Regarding **claim 4**, Goodman further discloses *wherein the single-media and multi-media electronic devices include one or more of telephones, personal computers (item 495c), fax machines (well known), and televisions running through set top boxes* [see Goodman, Figure 15, Col. 9, lines 47-54]. By this rationale **claim 4** is rejected.

11. **Claim 7** list all the same elements of **claim 1**, but in method form rather system form. Therefore, the supporting rationale of the rejection to **claim 1**, applies equally as well to **claim 7**. Furthermore, with regards to the steps of delivering [see Goodman, Col. 11, lines 1-18], installing [see Goodman, Col. 11, lines 34-49], connecting [see Goodman, Col. 11, lines 42-45], driving the telephone wire [see Goodman, Col. 12,, lines 45-54], and modulating the signals [see Goodman, Col. 24, lines 8-16]. By this rationale **claim 7** is rejected.

12. **Claim 8** list all the same elements of **claim 2**, but in method form rather system form. Therefore, the supporting rationale of the rejection to **claim 2**, applies equally as well to **claim 8**. By this rationale **claim 8** is rejected.

13. **Claim 9** list all the same elements of **claim 4** but in method form rather system form. Therefore, the supporting rationale of the rejection to **claim 4**, applies equally as well to **claim 9**.

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Regarding **claim 15**, Goodman further discloses *wherein individual ones of the converters are integrated into individual ones of the single-media or multi-media devices* [see rejection of claim 13, supra]. By this rationale **claim 15** is rejected.

14. Regarding **claim 16**, Goodman further discloses *wherein individual ones of the converters are internal modules in individual ones of the single-media or multi-media devices* [see rejection of claim 14, supra]. By this rationale **claim 16** is rejected.

### ***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. **Claims 1, 2 and 7** are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,167,120 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

***Serial No. 08/811,648 teaches in claim 1:***

*A networking system for a home or business site, comprising:*

**U.S. Patent No. 6,167,120 teaches in claim 1:**

A home networking system comprising:

***Serial No. 08/811,648 teaches in claim 1:***

*A bridge adapter unit having an inlet port for receiving public networking protocol signals:*

**U.S. Patent No. 6,167,120 teaches in claim 1:**

A customer demarcation unit at a customer's premise, having a port connected to outside telephone wiring and a port connected to outside telephone wiring and a port connected to the conventional telephone wiring in the customer's premise, receiving signals on the outside telephone wiring,

***Serial No. 08/811,648 teaches in claim 1:***

*A telephone wiring structure in the site, the wiring structure having multiple end points and one or more junctions, and connected at a single point to an outlet port of the bridge adapter unit:*

**U.S. Patent No. 6,167,120 teaches in claim 1:**

Conventional telephone wiring connected to telephone jacks in a customer's premises:

***Serial No. 08/811,648 teaches in claim 1:***

*Characterized in that the bridge adapter unit drives the telephone wiring structure according to a Local Area Network (LAN) protocol, and translates the public network protocol signals to the LAN protocol, modulates the signals in a manner to correct signal variations at the end points due to having multiple end points driven from a single point at the bridge adapter unit.*

**U.S. Patent No. 6,167,120 teaches in claim 1:**

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Driving the conventional telephone wiring in the customer's premises as a local-area (LAN) using a spectrum high frequency signal, converting the signals received to the protocol required by the LAN.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-5:00, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703) 305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

WCV

WCV  
Patent Examiner  
Art Unit 2152  
May 20, 2002

  
MARK H. RINEHART  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100